

REMARKS

Claims 43-46, 49-58, and 60-63 are pending herein. By this Amendment, Claims 47-48 and 59 are canceled; Claims 43, 46, and 60-61 are amended; and new Claims 62-63 are added. Support for the claim amendments and new claims is found in the specification at, *inter alia*, page 2, lines 1-6, page 7, lines 25-30, and page 12, lines 21-34. No new matter is added by this Amendment.

It is respectfully noted that Claim 48 was not rejected under the prior art, but only under 35 U.S.C. 112. Claim 48 is canceled and re-written as new Claim 62. Thus, Applicant requests that at least new Claim 62 be indicated as allowable.

I. Formal Matters

Although the U.S. Patent and Trademark Office has acknowledged receipt of the 2 priority documents (DE 198 48 863.7 and 199 15 713.8), the Office Action indicated that they cannot be found. Accordingly, Applicant filed Form PTO/SB/308 (Request to Retrieve Electronic Priority Application(s)) on September 22, 2010. In addition, a Form PTO/SB/308 was filed in related application U.S. Serial No. 12/899,605 on October 7, 2010.

Claim 48 was rejected under 35 U.S.C. 112, second paragraph, as assertedly being indefinite. Claim 48 is cancelled and rewritten as new independent Claim 62, thereby rendering the rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejections Under 35 U.S.C. 103(a)

Attached hereto is a Declaration Under 37 C.F.R. 1.132 of Mr. Holger Weber in support of the patentability of the claimed invention. The 1.132 Declaration details many significant advantages of the present invention and why the prior art cannot be combined to achieve the invention. A copy of the 1.132 Declaration will also be submitted via hand-carry so the coloring in Exhibits 5-7 will be made clearer to the Examiner. Alternatively, Applicant's representative would be pleased to e-mail the Exhibits to the Examiner upon request.

A. Claims 43-47, 49, 52-54, and 60-61

Claims 43-47, 49, 52-54, and 60-61 were rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 3,172,942 (Berg) in view of U.S. Patent No. 6,060,157 (LaPerre '157) and U.S. Patent No. 3,420,597 (Nellessen et al.).

1. Independent Claims 43 and 60-61

Berg discloses a reflecting transfer film comprising base carrier 10 (carrier coating 11 with plastic coating 12); transparent beads 14; pigment means 15 in bead-bond layer 16; heat-barrier film 17; and adhesive layer 18. See FIG. 1.

As acknowledged in the Office Action, Berg fails to teach or suggest that the base medium is adhesive-repellent or that the method steps are carried out in the order as claimed (Office Action at page 4). In addition, the Office Action acknowledges that the motif of Berg is printed in a reverse manner (Office Action at page 4).

LaPerre '157 does not overcome the deficiencies of Berg. La Perre '157 discloses transparent decorative articles formed on a transparent substrate, glass microspheres, bonding layer, optional layers and optional coatings, having an etched appearance or rainbow-like appearance depending on illumination conditions and viewing angle (Abstract).

Exposed transparent bonding layer 6 is applied to transparent substrate (e.g., glass surface). The transfer graphic is applied, in a mirror-reversed fashion, to the inside of a transparent substrate. See FIG. 1B and the discussion in LaPerre '157 in which requires viewing the transfer graphic from an outside surface (col. 1, lines 34-54; col. 3, lines 26-39; Examples 7-8).

The whole purpose of LaPerre '157 is for a viewer to look through a transparent substrate to glass microspheres. Light must pass through the transparent substrate, through the transparent adhesive and reinforcing layers, through the microsphere bonding layer and then to the microspheres. The microspheres disperse the light into

the visible spectrum and a part of it is refracted back at an angle different from the illumination angle (col. 10, lines 15-25; FIG. 6).

The Office Action asserts that LaPerre '157 discloses printing an image layer 4 directly onto an adhesive layer 6 on an adhesive-repellent peelable layer 13 (col. 19, lines 15-27; see FIG. 2). However, one of ordinary skill in the art would not have looked to LaPerre '157 in order to modify the teachings of Berg for the following reasons.

First, it is unclear how Berg and LaPerre '157 could be combined, given that the purpose of Berg is to create silhouettes that may be cut and applied to the outside of an underlying fabric; whereas, LaPerre '157 is directed to creating an appearance of an etched graphic on the inside of a clear transparent substrate, with light passing through not only the transparent substrate, but also through a transparent adhesive.

Second, the designs of both Berg and LaPerre '157 are in mirror-reversed fashion. See attached 1.132 Declaration at numbered paragraphs 11-14. Thus, any combination would not yield the claimed motif that is imprinted with a correct side in a plan view.

Third, unlike the reflective transfer of the present invention, Berg and LaPerre '157 only allow testing of the quality of a reflective transfer after application to a substrate. See attached 1.132 Declaration at numbered paragraphs 15-17. The claimed methods also allow for the control of specific color matchings that may be given from customers prior to applying the reflective transfer to a substrate, which is impossible with the transfers of Berg and/or LaPerre '157. See attached 1.132 Declaration at numbered paragraph 18.

Fourth, any combination of Berg and LaPerre '157 would cause a problem that the beads of Berg could not be provided with any reflective coating, since they would not be accessible due to Berg's required thermoplastic coating. See attached 1.132 Declaration at numbered paragraph 24A-B.

Nellessen et al. does not overcome the deficiencies of Berg and LaPerre '157. Nellessen et al. discloses a method for making retroreflective surfaces by applying a paint-like film of binder solids large pigment particles, and transparent glass

microspheres completely coated with a thin metal layer; drying the film; and applying an etching solution to remove the metal (col. 1, lines 15-30).

Any etching as required by Nellessen et al. would destroy the layer sequence of Berg or LaPerre '157, thereby rendering the transfer useless. Further, LaPerre '157 teaches away from etching. See attached 1.132 Declaration at numbered paragraphs 25-27.

Thus, it would not have been obvious for one of ordinary skill in the art to practice the methods of independent Claims 43 and 60-61 -- in particular imprinting a reflection ink layer comprising a colored ink and a plurality of reflection particles onto said transfer adhesive, wherein said reflection ink layer forms a motif that is imprinted with a correct side in a plan view -- in view of the combined teachings of Berg, LaPerre '157 and Nellessen et al. Reconsideration and withdrawal of the rejection are respectfully requested.

2. Claim 46

Even if Berg is interpreted as disclosing the use of white pigments, the use of a white or colored-covering adhesive as claimed in Claim 46 is excluded with any combination of Berg and LaPerre '157.

As noted above, the arrangement of layer in LaPerre '157 is viewed at from the outside, so that all layers have to be transparent (i.e., not white). Although LaPerre '157 teaches that it is possible to put some pigments in the layers, it has to be made sure according to LaPerre that the layers are transparent after application.

Thus, it would not have been obvious for one of ordinary skill in the art to practice the method of Claim 46 in view of the combined teachings of Berg, LaPerre '157, and Nellessen et al. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 50-51

Claim 50 was rejected under 35 U.S.C. 103(a) as obvious over Berg in view of LaPerre '157, Nellessen et al., and Applicant's Admitted Prior Art.

As noted in paragraph 14 of the 1.132 Declaration of Mr. Kaufmann filed on March 8, 2010, starting with the Temporary Removable Liner 19 of Berg would result in a screen printing machine (the mesh of the screens) unavoidably sticking to the self-adhesive Temporary Removable Liner 19. During a screen printing process (i.e., during printing of the several layers according to the present invention), the screen necessarily contacts a base medium and would therefore stick to the adhesive Temporary Removable Liner 19 of Berg if it were to serve as a base medium.

Thus, it would not have been obvious for one of ordinary skill in the art to practice the claimed methods in view of the combined teachings of Berg, LaPerre '157, Nellessen et al., and Applicant's Admitted Prior Art. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 51 was rejected under 35 U.S.C. 103(a) as obvious over Berg in view of LaPerre '157, Nellessen et al. and further in view of U.S. Patent No. 5,602,775 (LaPerre '775). Claim 51 is allowable based upon the patentability of Claim 43 as discussed above, as well as for the additional features it recites. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Claims 55-58

Claims 55-58 were rejected under 35 U.S.C. 103(a) as obvious over Berg in view of LaPerre '157, Nellessen et al. and further in view of LaPerre '775.

As acknowledged in the Office Action, Berg, LaPerre '175 and Nellessen et al. do not teach or suggest imprinting a non-reflective intermediate ink layer on the transfer adhesive; and imprinting the reflection ink layer onto the non-reflective intermediate ink layer, as recited in Claim 55.

LaPerre '775 does not overcome the deficiencies of Berg, LaPerre '175 and Nellessen et al. LaPerre '775 discloses glass microsphere coated articles (Abstract). Citing col. 14, lines 47-52, the Office Action asserts that LaPerre '775 discloses printing including additional colored polymeric ink layer on a transfer adhesive (Office Action at page 13).

However, the optional, colored ink layer 14 (or optional continuous colored polymeric layer 15) is attached to an adhesive layer 13 on a side of the adhesive layer opposite to that which has the glass beads 11. See FIG. 4, col. 17, lines 5-18. Thus, the glass beads 11 are separated from the color layer by adhesive layer 13. See attached 1.132 Declaration at numbered paragraphs 31-33.

Accordingly, LaPerre '775 does not teach (1) imprinting a non-reflective intermediate ink layer on the transfer adhesive; and then (2) imprinting a reflection ink layer comprising a colored ink and a plurality of reflection particles onto the non-reflective intermediate ink layer, as recited in Claim 55.

Regarding Claims 56-57, LaPerre '775 clearly does not teach or suggest that an intermediate ink layer comprises white ink. Col. 15, lines 4-10 of LaPerre '775 discloses a broad range of color may be achieve using a 4-color graphic process (i.e., magenta, yellow, black, cyan as disclosed at col. 20, lines 5-10). In contrast, the current specification clearly indicates that importance of having an intermediate ink layer comprising white ink at page 12, lines 4-19.

Thus, it would not have been obvious for one of ordinary skill in the art to practice the claimed methods in view of the combined teachings of Berg, LaPerre '157, Nellessen et al., and LaPerre '775. Reconsideration and withdrawal of the rejection are respectfully requested.

D. Claim 62

As noted above, the subject matter of Claim 48 was not rejected over the prior art.

None of the cited art teaches or suggests, *inter alia*, applying a transfer adhesive/reflection ink mixture comprising a colored ink and a plurality of reflection particles on the adhesive-repellent base medium to form a motif comprising at least two parts and imprinted with a correct side in a plan view; drying the transfer adhesive / reflection ink mixture; applying a transfer film on the dried transfer adhesive/reflection ink mixture; and removing said adhesive-repellent base medium to expose a layer of the transfer adhesive, as recited in independent Claim 62. Allowance of at least Claim 62 is respectfully requested.

III. Secondary Considerations

The attached 1.132 Declaration illustrates that the significant advantages of the present invention solves long-felt needs in the area of reflective transfers. See attached 1.132 Declaration at numbered paragraphs 38-40.

Further, the worldwide recognition of patentability is shown by the large number of foreign patent offices that have granted patents for the present invention. This fact should be given probative weight as indicia of nonobviousness. See attached 1.132 Declaration at numbered paragraph 41.

IV. MPEP and application of KSR

Regarding MPEP 2144.04 (IV)(c), Applicant respectfully submits that the order of the claimed steps results in new and unexpected advantages/results as illustrated by the attached 1.132 Declaration and by the earlier Declaration by Mr. Kaufmann. Accordingly, any *prima facie* case of obviousness has clearly been rebutted.

Applicant also maintains that, under an obviousness analysis in view of *KSR*, there has been no demonstration that: (1) there a design need or market pressure to solve a problem; (2) there are a finite number of identified, predictable solutions; and (3) one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. In any event, Applicant has clearly rebutted any obviousness argument with the attached 1.132 Declaration and earlier Kaufmann Declaration, which show that one of ordinary skill in the art would not have combined

the prior art in the way asserted by the Examiner with any reasonable chance of success.

Applicant further maintains that the Examiner is using the claims as a template and reconstructing the prior art in a way that is foreign to the teachings of the art and to what one of ordinary skill in the art would have expected.

V. Conclusion

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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